

Hidcaki Tojo will be filed in the very near future.

Rejection Under 35 USC §102(b) or §103(a)

The Examiner has maintained the previously presented rejection of claim 20 under 35 USC §102(b) as anticipated by or, in the alternative, under 35 USC §103(a) as obvious over Swidler '436. See item 3 of the Office Action. In addition to arguments previously presented by the Examiner in the Office Action of 7 June 1999, it is the Examiner's further position (responding to applicant's asserted position that Swidler teaches away from applying his strippable paint to a painted surface of an automobile prior to mounting of an engine and functional parts to the automobile in an assembly process in that Swidler's full disclosure of his invention has nothing to do with vehicle assembly) that : "... Swidler inferentially teaches that his coating is applied to the vehicle during the assembly process" based on his teachings at column 1 of the patent, including an alleged teaching that plastic or canvas covers have been used to protect the surface paint finishes during the manufacturing and transportation thereof; and that Swidler's main focus is a general method of protecting surfaces without limiting it to any time frame relative to the manufacture of the vehicle.

Applicant's Response

Upon careful consideration applicant respectfully traverses such rejection, and submits that claim 20 is clearly patentably distinct over Swidler, for those reasons set forth in the most recent Brief on Appeal, e.g., although Swidler generally discloses that automotive finishes are subject to a variety of injuries during the assembly process, shipping and storage, Swidler's full disclosure, including specific problems addressed and solutions thereto, have nothing to do with (and hence teaches away from) vehicle manufacture-assembly, while Swidler never discloses (expressly or implicitly) or in any way suggests the particular assembly step defined in claim 20 involving use of strippable paint during mounting an engine and functional parts to the vehicle .

In this regard, applicant respectfully traverses the Examiner's new allegations of Swidler's inherent teachings and main focus because such allegations are not supported by Swidler's actual disclosure or by any other evidence of record. For example, Swidler does not disclose use of plastic or canvas covers to protect the surface paint finishes during the *manufacturing* and transportation thereof

(emphasis added). Rather, his only discussion of the covers, at col. 1, lines 41-46, is exclusively in relation to "... mass shipments or typical driving", and he specifically comments that any such use is labor intensive, prohibitively expensive *for mass shipments or typical driving*, and creates solid waste problems as the covers are not readily reusable (emphasis added). The protective covers conventionally used during a vehicle assembly process are heavy duty and reusable, unlike the covers which Swidler indicates are replaced by his coatings, and this characteristic leads to a considerable labor cost for the use of same as discussed below and in the Declarations Under 37 CFR §1.132 filed herewith.

Similarly, there is nothing inferential in Swidler's disclosure suggesting use of his protective coatings as a substitute for conventional, re-usable anti-scratch covers during a conventional vehicle assembly step of mounting an engine and functional parts to the automobile body. Swidler's background discussion at his at his column 1 begins very generally mentioning injuries to vehicle finishes during the assembly process and transportation from the assembly plant to retail locations, but then moves away from such general discussion to specific problems encountered by vehicle finishes following the manufacture as appropriate applications for his finishes, never again mentioning vehicle assembly even generally, let alone the specific assembly step as claimed.

On the other hand, applicant respectfully submits that while Swidler generally discloses a method of protecting finished surfaces, he never indicates that such method is appropriate or useful in all situations. Rather, Swidler's disclosure of uses for his method is limited in the sense that he does not indicate or suggest that his protective coatings may be applied to protect against scratches in any situation. Rather, through his discussion of specific problems and applications for the coatings, all involving vehicles being transported and/or simple application and air drying of the coatings, Swidler indicates that there are limits to useful applications for the coatings, e.g., the manner in which Swidler simply air-dries his coatings after application over a paint finished surface of an automobile is inconsistent with use during a (continuous) automobile assembly process.

Again, the present claims do not define use of the strippable paint in general relation to a vehicle manufacturing method, but in relation to a specific assembly step (i.e., mounting an engine and functional parts to the vehicle "... while said strippable paint remains coated on the painted surface"). Swidler not only fails to generally disclose use of a strippable paint in a

vehicle manufacturing method, but certainly does not disclose, anticipate or suggest this specific step in any way.

In this regard, establishing *prima facie* anticipation of a claimed invention under 35 USC §102(b), "... requires the presence in a single prior art reference disclosure of each and every element of the invention, arranged as in the claim." Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 221 USPQ 481, 485 (Fed. Cir. 1884). Here, *prima facie* anticipation is not established relative to Swidler because the reference clearly does not (expressly or inherently) disclose the claimed assembly step involving mounting of an engine and functional parts to a vehicle.

On the other hand, the Courts and the Board of Patent Appeals and Interferences (BPAI) have consistently held that, for purposes of establishing obviousness under 35 USC §103, a rejection advanced by an Examiner must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art, and that the Examiner may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis. Ex Parte Hamond, 41 USPQ2d 1217, 1220, citing In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968). Here, there simply is no suggestion or indication in Swidler of using his strippable paints to protect a vehicle's paint finish during an assembly step involving mounting of an engine and functional parts to a vehicle.

Also in this regard, applicant respectfully submits that the unobviousness of the invention defined in claim 20 is strongly reflected by the significant, practical advantages which the invention achieves over conventional assembly processes as discussed in the Declarations Under 37 CFR §1.132 submitted herewith. Certainly, Swidler never addresses the disadvantages related to the conventional assembly process involving reusable protective covers, nor does he address or achieve the significant advantages which are achieved by the claimed invention.

Based on the foregoing, applicant respectfully submits that the rejection of claim 20

based on the Swidler reference is overcome, and it is respectfully requested that such rejection be reconsidered and withdrawn.

Rejections Under 35 USC §103(a)

The Examiner has rejected claims 20, 26 and 38 under 35 USC §103(a) as obvious over applicant's admitted prior art as described at pages 20-21 of the specification in view of Swidler '436 and the state of the art, as presented at item 4 of the Office Action. It is the Examiner's position that one skilled in the art would have found it obvious to use Swidler's strippable paint in place of an anti-scratch cover (such as applicant has disclosed is conventionally used in automobile manufacturing) during a vehicle assembly process, to realize the benefits thereof, that it would have been obvious to perform a step of finished product inspection (claim 26) following an assembly step, and that the subject matter of the other rejected claims "is held to be an obvious matter of choice...."

Applicant's Response

Upon careful consideration applicant respectfully traverses such rejection, and again submits that each of the rejected claims is clearly patentably distinct over the conventional art and Swidler, for those reasons discussed above in relation to deficiencies of Swidler relative to claim 20 which are not overcome by any discussion at pages 20-21 of the present specification, and because the proposed hypothetical modification of the prior art assembly process (involving conventional use anti-scratch covers) at pages 20-21 of the application in view of a select teaching of Swidler is improperly based on a suggestion coming entirely from the Examiner (based on impermissible hindsight from applicant's disclosure), rather than from any teaching or suggestion which may be fairly gleaned from the actual prior art teachings as a whole.

Regarding the proposed hypothetical modification, again, applicant respectfully submits that Swidler does not disclose a vehicle assembly process, the use of his protective coating compositions during any step of an assembly process, or the use of his protective coatings to replace reusable covers during a vehicle assembly process involving mounting of an engine and

functional parts to the vehicle; but instead exclusively focuses on the use of his coating compositions for protecting new vehicle and other object finishes during storage and transportation. On the other hand, at pages 20-21 of the present specification it is discussed that , "... rustproofing wax or strippable paint is coated onto the painted surfaces of automobiles *after* they pass through a finished vehicle inspection step *after* being assembled.... (emphasis added)" As will be understood, such discussion is simply consistent with, and nothing more than, Swidler's teaching of applying his strippable paints to vehicle finishes after the assembly process to protect same during transportation to retail locations.

Given the actual and specific teachings of Swidler and as presented at pages 20-21 of the present specification, applicant respectfully submits that persons of ordinary skill in the art would not consider it obvious to somehow modify the conventional vehicle assembly process by replacing use of conventional anti-scratch covers with use of protective films formed using Swidler's protective compositions during the step of mounting of an engine and functional parts to the vehicle, as proposed by the Examiner, because there is no motivation to do so (apart from impermissible hindsight gained from applicant's disclosure). The conventional process discussed at pages 20-21 of the specification already uses strippable paint in precisely the same manner as disclosed by Swidler, i.e., after the assembly process, whereas neither reference discloses or suggests the use of the strippable paint to replace conventional reusable protective covers during the assembly process.

Absent any motivation for a proposed modification-combination of prior art teachings which may be fairly glean from the prior art references themselves or from generally available knowledge in the art, the proposed modification-combination is not obvious under 35 USC §103(a). In re Fine, 5USPQ2d 1596, 1598, 1599 (Fed. Cir. 1988).

Based on the foregoing, applicant respectfully submits that the rejection of claims 20, 26, and 38 based on applicant's admitted prior art on pages 20-21 of the specification and the Swidler reference is overcome, and it is respectfully requested that such rejection be reconsidered and

withdrawn.

The Examiner has also rejected claims 20, 26, 27, 30-33, 37 and 39-42 under 35 USC §103(a) as being unpatentable over Swidler '436 in view of Nelson et al. (US Patent 4,907,533), as presented at item 5 of the Office Action. It is the Examiner's position that it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Swidler's disclosed drying process to include two-stage drying based on the teachings of Nelson in order to achieve the disclosed advantages thereof, whereas other specific features of the claims are considered to be obvious matters of design choice, etc.

Upon careful consideration applicant respectfully traverses such rejection, and submits that each of the rejected claims is clearly patentably distinct over the Swidler and Nelson references, for those reasons discussed above regarding the deficiencies of Swidler relative to claim 20 (which are not overcome by Nelson whose disclosure does not relate to strippable paints or use of same during a vehicle assembly process); because the proposed modification of Swidler's surface protecting process relative to a vehicle assembly process involving Class A Surfaces such as disclosed by Nelson is improperly based on a suggestion coming entirely from the Examiner (guided by impermissible hindsight of applicant's disclosure), rather than on any teaching or suggestion which may be fairly gleaned from the references themselves; and because additional features set forth in some of the dependent claims, such as features involving the stabilizing step, are not taught or suggested by the references, nor are these features obvious matters of design choice, etc.

Regarding the proposed modification of Swidler's process, Nelson's disclosed method specifically pertains to formation of high gloss Class A surfaces "... having as high a quality of finish as possible" because this improves the marketability of the vehicle, whereas Nelson distinguishes such Class A Surfaces from finishes on other portions of the vehicle are not readily visible to the end user, indicating that the finishes on such other portions "... only require a finish sufficiently good to protect the vehicle's surface from the elements."

Given that Swidler's strippable paint coatings are not Class A Surfaces and that there is not concern regarding the appearance of same to end users of the vehicles (in that the coatings are removed before sale to the end user), persons skilled in the art would not consider it obvious to hypothetically modify Swidler's process to involve two-stage drying of a coated strippable paint based on the teachings of Nelson because there is no need or motivation for doing so in that Swidler's strippable paint coatings are not Class A Surfaces.

Similarly, persons skilled in the art would not consider it obvious to hypothetically modify Swidler's process by incorporating a two-stage drying process, as well as using Swidler's strippable paints in an automotive assembly process involving mounting of an engine and functional parts to the vehicle while the strippable paint is coated on paint finished surfaces, based on Nelson's disclosure (again) because there is no motivation for doing so given that neither reference discloses use of strippable paints during such an automobile assembly process.

Moreover, applicant respectfully submits that even if the teachings of the applied references were hypothetically combined, any combination resulting from the full, fair teachings of the references would not achieve or make obvious the invention as claimed. For example, neither reference discloses or suggests a vehicle assembly process involving strippable paint as defined in claim 20, or a finished product inspection step following such assembly process as defined in claim 26. Further, neither reference discloses or suggests a stabilizing step, in addition to preliminary and non-preliminary drying steps, as defined in claims 31, 32 and 40, whereas Nelson teaches away from such a stabilizing step. Particularly, Nelson discloses a vehicle painting operation in which a painted coating is initially exposed to IR radiation heating for 20-30 seconds to set an applied coating and then heated in a convection oven for 15 minutes to completely cure the coating. He does not use a stabilizing step prior to exposure to IR radiation, nor does he disclose a specific stabilizing step conducted at room temperature or at the specific temperature and humidity defined in claims 32 and 40.

In this regard, applicant respectfully traverses the Examiner's allegation regarding the

claimed features being obvious matters of design choice because the specifically claimed features involving a particular assembly step and a separate stabilizing step are completely beyond the disclosures of the references and of any evidence of record such that they can hardly be viewed as obvious matters of design choice. This is not a matter of optimizing features taught by the references, but features which are not addressed at all by the references.

In view of the foregoing, applicant respectfully submits that the rejection based on Swidler and Nelson is overcome, and it is respectfully requested that the rejection be reconsidered and withdrawn.

New claim 43 is believed to be allowable for those reasons discussed in relation to claims 20 and 31, as well as for the merits of the additional feature set forth in the claim.

Conclusion

In conclusion, applicant has overcome the Examiner's rejections of claims as presented in the Office Action; and moreover, applicant has considered all of the references of record, and it is respectfully submitted that the invention as defined by each of the present claims is clearly patentably distinct thereover.

The application is now believed to be in condition for allowance, and a notice to this effect is earnestly solicited.

Favorable reconsideration is again respectfully requested.

Respectfully submitted,

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43. (New) The method of claim 31, wherein said stabilizing step is performed by allowing the automobile to stand for a long time after application of the strippable paint before said preliminary drying step.

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